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| 09/778,228      | 02/06/2001  | Jonathan N. Howarth  | SU-7155-A           | 5749             |

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EXAMINER

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| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1616

DATE MAILED: 02/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

778228

Applicant(s)

HOWARTH et al

Examiner

NEIL Cery

Group Art Unit

16/6 16

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 12/17/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-40 is/are pending in the application
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-40 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Receipt is acknowledged of amendment only of 12/17/02. Regrettably,

The timely submission under 37 CFR 1.129(a) filed on 12/17/02 is not fully responsive to the prior Office action because applicant has not at all addressed double patenting, restriction, election requirements, and is in this respect non-responsive. In order to advance prosecution, the following rejections are made and the restriction/election reiterated. Since the submission appears to be a *bona fide* attempt to provide a complete reply to the prior Office action, applicant is given a shortened statutory period of ONE MONTH or THIRTY DAYS from the mailing date of this letter, whichever is longer, to submit a complete reply. This shortened statutory period supersedes the time period set in the prior Office action. This time period may be extended pursuant to 37 CFR 1.136(a). If a notice of appeal and the fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant is construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). The appeal stands dismissed.

The following rejections would still be applicable:

Claims 1-7, 11-17, 19-21, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bottom et al 4,597,941.

The rejection of record is maintained, but it is acknowledged Bottom does not specify the presence of a Label.

DBDMH and either DCDMH or TCICA, and an inactive, dye, are known (column 5, bottom-column 6) and constitute and article as package, a container, with solid or

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liquid, including a dye and other inactive-cleaner-with a single disinfectant (column 4, line 42-55). Solid soap with dye, thus, the soap containing binder (line 30-32/ column 5) is utilized. The DBDMH is shown as 100% delivery of hypohalite concentration can be adjusted to provide 2-15 ppm (column 8, top). PH can be adjusted to maintain pH of 6-9 (Table III); no patentable weight is given to future intended use of the article (wastewater, brewery, etc-as at claim 16). No patentable weight is given to the future intended use of the article (wastewater, brewery, etc-as at claim 16). No patentable weight is given to the attachment of written stickers and/or labels.

Claims 1-7, 11-13, 16-19, 25-33, 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al 4,119,535.

Articles-water treatment dispensers-of DBDHI with no inactive binders (unspecified in instant claims) in solid form as shown (column 5) pH is maintained at about 7.9-7.4 (column 8). Additional compatible inactives (claim 2) are shown, as are additional actives, (TCC or NaDcc (column 9, lines 4-15). Additional hydantoins include dibromo ethylmethyl and the dibromomethyl isobutyl forms (column 7, bottom). No patentable weight is given to future intended use, or to attachment of a label or sticker or to what is printed on the label or sticker.

The is no non-obvious and/or unexpected results obtained since the prior art is well aware of the use of dibromo-hydantoins and the use of additives for the functionality for which they are known to be used is not a basis for patentability. The selection of active is a result effective parameter determinable by artisan as desired. Applicant has not provided any objective evidence of criticality, non-obvious or

unexpected results that the administration of the particular ingredients', concentrations, forms or labels provides any greater or different level of prior art expectation as claimed.

Claims 25, 39 and 40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-36 of copending Application No. 09/484938. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the conflicting claims are not identical, they are not patentably distinct from each other because although the instant methods are nominal, they do overlap the methods of 484,938.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 25 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 16, 17, 23, 30-33 of copending Application No. 09/974626. Although the conflicting claims are not identical, they are not patentably distinct from each other because the methods incorporate the composition of claims 1, 4, 6, 7, 16-24, which are those of the 977' methods, with labeling and packaging considered obvious, and mandated by Government regulations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 25 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending

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Application No. 09/775516. Although the conflicting claims are not identical, they are not patentably distinct from each other because here, too the claim 25 methods using the compositions of claims 1, 4, 6 and 7 is seen as encompassing the 09/775,516 application claim, with packaging and Labeling obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-24, drawn to article of dibromo hydantoin active, classified in class 514, subclass 389.
- II. Claims 36-38, drawn to an article of non-hydantoin form, classified in class 252, subclass 175.
- III. Claims 25, 39 and 40 are, drawn to methods, classified in class 424, subclass 405.

The inventions are distinct, each from the other because:

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Inventions I, II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case in the instant case the method of Group III can be practiced with materially different products such as H<sub>2</sub>O<sub>2</sub>.

Group I, II, III have attained recognition in the art as separate subject for inventive effort as evidenced by their separate classification. Separate classification is also evidenced of the different field of search that would be required to search each invention. Therefore, the inventions outlined above are distinct. This, in addition to the fact that a search and examination of the entire application would place an undue, serious burden on the Examiner, render the present restriction requirement proper for examination purposes.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

This application contains claims directed to the following patentably distinct species of the claimed invention: species of active hydantoins; single or mix.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-8, 11-24, 26-33, 36 are generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: species of active non-hydantoin: hpochlorite, cyanurate.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 16-24, 26-38 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the



case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant's arguments filed on 12/17/02 have been fully considered but they are not persuasive. Applicants arguments have been considered, and as the references did not provide the novelty of packages and Labels, those rejections to be maintained have been restructured, amended claims and reconsideration to be given upon applicants species and invention election.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Because the above restriction/election requirement is complex, a telephone call to applicant's agent to request an oral election was not made. See M.P.E.P. Sec. 812.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703)308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Levy/LR  
January 30, 2003

**NEIL S. LEVY**  
**PRIMARY EXAMINER**